

REMARKS

This Reply is in response to the Office Action mailed on February 27, 2004 in which Claims 1-12 and 21-37 were rejected. With this Reply, Claims 1, 7, 9, 10, 12, 21 and 30 are amended; Claims 27, 28 and 31 are canceled; and Claims 38 and 39 are added. Claims 1-12, 21-26, 29-30 and 32-39 are presented for reconsideration and allowance.

I. Examiner Interview Summary.

On May 11, 2004, a telephonic interview was held between Examiner Prone and Applicants' attorney, Todd A. Rathe. Claims 28 and 31 were discussed. It was agreed upon that Taylor, U.S. Patent No. 6,318,917, fails to disclose a tear-off edge that extends along an axis oblique to the axis along which the conveyor moves the grasper. Although the Examiner indicated that amending Claim 1 to incorporate the limitations of Claim 28 and amending Claim 30 to incorporate the limitations of Claim 31 would overcome the rejections based upon Taylor, the Examiner indicated that a further search would be necessary.

Applicants wish to thank Examiner Prone for the opportunity discuss the rejections and for Examiner Prone's suggestions for amending the claims to overcome the prior art of record.

II. Rejection of Claims 1, 2, 5-8, 11, 12, 21 and 26-27 Under 35 U.S.C. § 102(e) Based Upon Taylor.

Paragraph 3 of the Office Action rejected Claims 1, 2, 5-8, 11, 12, 21 and 26-27 under 35 U.S.C. § 102(e) as being anticipated by Taylor, U.S. Patent No. 6,318,917. With this Reply, Claim 28 is canceled with its limitations incorporated into independent Claim 1, independent Claim 12 is amended, independent Claim 21 is amended and Claim 31 is canceled with its limitations incorporated into independent Claim 30. Claims 1, 2, 5-8, 11, 12, 21, 26, 29-30 and 32-37, as amended, overcome the rejection based upon Taylor.

A. Claim 1.

Claim 1, as amended, recites that the tear-off edge extends along a second axis oblique to the first axis along which the conveyor moves the grasper. As noted above, it was agreed upon during the Examiner interview held on May 11, 2004 that the above amendment to Claim 1 overcomes the rejection based upon Taylor. Claims 2, 5-8 and 11 depend from Claim 1 and overcome the rejection for the same reasons.

B. Claim 12.

Claim 12, as amended, recites a tool which includes an actuator which moves a first jaw along a first axis relative to a second jaw into and out of engagement with the tearable medium and a conveyor which moves the first and second jaws along a second axis that forms an oblique angle with the first axis when the tearable medium is grasped by the first and second jaws. Taylor fails to disclose a pair of jaws which move relative to one another along a first axis and a conveyor which moves both jaws along a second axis oblique to the first axis. Accordingly, Claim 12, as amended, overcomes the rejection based upon Taylor. Claim 29 depends from Claim 12 and overcomes the rejection for the same reasons.

C. Claim 21.

Claim 21, as amended, recites a tool having a conveyor configured to move a first jaw and a second jaw to move a printable medium against a tear-off edge and an actuator having a slide along which the second jaw linearly moves towards and away from the first jaw, wherein the slide of the actuator is oriented at an oblique angle with respect to the conveyor. Taylor fails to disclose a conveyor which moves a pair of jaws, wherein one of the jaws slidably attaches to a slide oriented at an oblique angle with respect to the conveyor. Accordingly, Claim 21, as amended, overcomes the rejection based upon Taylor. Claims 22-26 depend from Claim 21 and overcome the rejection for the same reasons.

D. Claim 30.

Claim 30, as amended, recites a printing system which includes an edge that extends along a first axis and a grasper movable along a second axis oblique to the first axis. As

agreed upon during the Examiner interview held on May 11, 2004, Taylor fails to disclose an edge against which a tearable medium is urged which extends along a first axis oblique to a second axis along which the grasper is moved. Accordingly, Claim 30 overcomes the rejection based upon Taylor. Claims 32-37 depend from Claim 30 and overcome the rejection for the same reasons.

III. Rejection of Claims 3, 4, 9, 10, 22 and 23 Under 35 U.S.C. § 103 Based Upon Taylor and Blessing et al.

Paragraph 5 of the Office Action rejected Claims 3, 4, 9, 10, 22 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Taylor in view of Blessing et al., U.S. Patent No. 3,951,400. Claims 3, 4, 9 and 10 depend from Claim 1 and overcome the rejection based upon Taylor in view of Blessing et al. for the same reasons discussed above with respect to Claim 1. Claims 22 and 23 depend from Claim 21 and overcome the rejection based upon Taylor in view of Blessing et al. for the same reasons discussed above with respect to the rejection of Claim 21.

In addition, Claim 9, which depends from Claim 1, further recites that the tool includes an electromechanical valve which passes a flow of fluid to the conveyor to move the grasper. Paragraph 5 of the Office Action acknowledges that Taylor fails to disclose an electromechanical valve which allows fluid to flow to a conveyor for moving the grasper. As a result, the Office Action additionally relies upon Blessing et al. which discloses a cloth mover and stacker. The Office Action asserts that it would be obvious to provide Taylor with an electromechanical valve “to allow for more efficient clamping means.”

However, in contrast to the assertions made in paragraph 5, it would not be obvious to modify the gasoline-dispensing system of Taylor based upon the cloth mover and stacker of Blessing et al. In particular, it is a well-settled principle that with regard to a rejection under 35 U.S.C. § 103, the proposed modification cannot render the prior art unsatisfactory for its intended purpose (MPEP 2143.01) and that the proposed modification cannot change the principle of operation of a reference (MPEP 2143.01). In the present case, Taylor utilizes a motor and a chain 54 for the specific purpose of moving carrier 24 within slot 28a between

two opposite facing positions on opposite sides of a gasoline-dispensing system. As emphasized in the Background of the Invention section of Taylor, separate printing units take a considerable space and add to the complexity of the dispensing systems. In the Summary of the Invention section of Taylor, the invention is described as a gasoline-dispensing system and method according to which a single printer can print receipts for customers dispensing gasoline from both ends of a dispenser. To alternatively replace the motor and chain of Taylor with a pneumatic cylinder and a pneumatic line 66 and 68 of Blessing et al. would destroy the intended function of Taylor and would render Taylor unsatisfactory for its intended purpose. Accordingly, Applicants respectfully request that the rejection of Claim 9 based upon Taylor in view Blessing be withdrawn for this additional reason. Claim 10, as amended, depends from Claim 9 and overcomes the rejection for the same reasons.

IV. Rejection of Claims 24 and 25 Under 35 U.S.C. § 103 Based Upon Taylor, Blessing and Miller.

Paragraph 6 of the Office Action rejected Claims 24 and 25 under 35 U.S.C. § 103 as being unpatentable over Taylor in view of Blessing and further in view of Miller, U.S. Patent No. 6,590,387. Claims 24 and 25 depend from Claim 21 and overcome the rejection for the same reasons discussed above with respect to Claim 21.

V. Added Claims.

With this Reply, Claims 38 and 39 are added. Added Claim 38 depends from Claim 37 and further recites that the first surface and the second surface are movable along an axis perpendicular to the axis of the edge. Added Claim 39 depends from Claim 7 and recites that the second axis along which the tear-off edge extends is perpendicular to the third axis along which the first jaw is actuatable relative to the second jaw. The prior art of record fails to disclose or suggest these features of added Claims 38 and 39.

VI. Conclusion.

After amending the claims as set forth above, Claims 1-12, 21-26, 29-30 and 32-39 are now pending in this application.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-0872.

Respectfully submitted,

Date

May 21, 2004

By

Todd A. Rathe

FOLEY & LARDNER LLP
777 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-5306
Telephone: (414) 297-5710
Facsimile: (414) 297-4900

Todd A. Rathe
Attorney for Applicant
Registration No. 38,276